UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,323	09/18/2003	David J. Payne	08049.0933	6243

		EXAMINER
22852 7590 04/05/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP		JOSEPH, TONYA S
901 NEW YORK AVENUE, NW		

ART UNIT	PAPER NUMBER
3628	

WASHINGTON, DC 20001-4413

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
	10/665,323	PAYNE ET AL.
Office Action Summary	Examiner	Art Unit	
	Tonya Joseph	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *08/24/2004*.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20070327

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 1-10, 22, 34 and 46 are rejected under 35 U.S.C. 112, second paragraph,
as being indefinite for failing to particularly point out and distinctly claim the subject
matter which applicant regards as the invention.

3.   Claims 1 and 2-4 recite the limitation "the first address" in line 8 and line 1
respectively. There is insufficient antecedent basis for this limitation in the claim.

4.   Claims 10-11 recite the limitation "at least one of receiving and providing" in line
1. There is insufficient antecedent basis for this limitation in the claim.

5.   Claims 10, 22, 34 and 46 recite the limitation, wherein at least one of receiving
and providing further comprises utilizing at least one of regular mail, e-mail, facsimile,
internet, and an interactive voice response system, however it is unclear whether the
interactive voice response system is to be considered in the alternative or is a required
limitation in addition to one of the aforementioned alternatives. For Examination
purposes, Examiner is interpreting the interactive voice response system is to be
considered in the alternative.

6.   Claims 5-9 contain the same deficiencies as claim 1 through dependency and as
such, are rejected for the same reasons.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   Claims 1-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9.   Claims 1,13, 25 and 37 recite the limitation "determining if the first unresolved address matches the incorrect address record of the resolved address" and outputting or providing the correct address record if the first address matches the incorrect address record " The use of open-ended conditional language would not render the entire claim useful, tangible or concrete. The language presented only makes allowances for when the first unresolved address matches the incorrect address record of the resolved address. There is no allowance made in the event that the first unresolved address does not match the incorrect address record of the resolved address. As the claim is currently presented, it could be possible that there would be no action to be performed when the method is practiced or no action by a program. Applicant's disclosure, paragraph 58 lines 7-10 further provide evidence of the possibility of no result, *"However, if it was determined at decision block 430 that the first address does not match the incorrect address record of the resolved address, exemplary method 400 ends at stage 450".* In this case, there would be no concrete, tangible or useful outcome, due to this lack of information, this would constitute non-statutory material.

10.   Claims 2-3 further recite open-ended conditional usage statements and as such

are rejected for the same reasons.

11.   Claims 7, 19, 31 and 43, recite the limitation, "wherein a delivery system operator

at least one of verifies, validates, and supplies missing or incorrect information".

The broadest reasonable interpretation of the claimed invention as a whole

encompasses a human being. Applicant's disclosure, paragraph 56 lines 7-9 further

provide evidence of the use of a human being, *"The unresolved address may be sent by*

the delivery system operator or by any other person or enterprise seeking address

resolution". A delivery system operator, including a human being is not patentable

subject matter, and as such renders the claims non-statutory under 35 U.S.C. 101.

12.   Claims 4-6, 8-18, 20-30 and 32-42 contain the same deficiencies as their

preceding claims through dependency and as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

14.   Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Allen et al. U.S. Patent No. 5,422,821 in view of Anchor (Reference U of the attached

PTO-892).

15.   As per Claims 1, 13, 25 and 37 Allen teaches saving a resolved address, the

address being resolved by at least one of a plurality of address resolution processes

(see Col. 8 lines 5-14 and Col. 2 lines 57-67, Examiner is interpreting stored information

in the database as having been saved). Examiner is further interpreting a NCOA

database as an address resolution process; the resolved address including a correct

address record and an incorrect address record (see Col. 7 lines 1-10 and Col. 2 lines

57-67);

Allen does not explicitly teach receiving a first unresolved address and determining if

the first unresolved address matches the incorrect address record of the resolved

address; Anchor teaches, Anchor, using its United States Postal Service approved

address-matching software, processes your lists and makes all necessary address

corrections (see pg. 2 para. 7 lines 4-6 and para. 8).

NCOA Match - corrected address Is provided		
MAIL FILE	NCOA DATABASE	NEW ADDRESS
Paul Jones 123 Main Street Anytown CT 06084	Paul Jones 123 Main Street Anytown CT 06084	Paul Jones 39 Oak Street Anytown MA 01245
John Smith 481 Elm St, Apt 4A Anytown CA	John Smith 481 Elm St, Apt 4A Anytown CA 90241	John Smith 11 Duck Lane Anytown IL 61411

Allen does not explicitly teach outputting or providing the correct address record if

the first address matches the incorrect address record. Anchor teaches, Anchor, using

its United States Postal Service approved address-matching software, processes your

lists and makes all necessary address corrections. In addition, the powerful software

will also standardize your addresses and add ZIP+4 Codes to your address file. The

18.   As per Claims 4, 16, 28 and 40, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein the first address corresponds to an item being processed for

delivery in an item delivery system (see Col. 2 lines 1-3).

19.   As per Claims 5, 17, 29 and 41, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 4, 16, 28 and 40. Allen

further teaches wherein the item delivery system comprises the United States Postal

Service (see Col. 5 lines 39-53). Although, Allen discloses a delivery system as set

forth above; Examiner notes the recitation; wherein the item delivery system comprises

the United States Postal Service constitutes intended use language and as such is

afforded little patentable weight.

20.   As per Claims 6, 18, 30 and 42, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 4, 16, 28 and 40. Allen

further teaches wherein the item comprises at least one of a mailpiece (see Col. 8 lines

19-24). The recitation, "a United States Postal Service Priority Mail package, a United

States Postal Service Express Mail Package, a United States Postal Service Global

Express Mail Package, and a United States Postal Service Global Express Guarantee

Package" is merely a statement of intended use and as such is afforded little patentable

weight.

NCOA COA file is updated weekly so your records are always as current and accurate

as possible (see para. 7 lines 4-10 and para. 8). It would have been prima facie

obvious to one of ordinary skill in the art at the time of invention to modify the teachings

of Allen to include the teachings of Anchor in order to provide a marketer with greater

flexibility in identifying a probable move, as taught in Anchor pg. 3 para. 4 lines 1-2.

16.   As per Claims 2, 14, 26 and 38, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1,13, 25 and 38. Allen

further teaches processing the first address if the first address does not match the

incorrect address record (see Col. 6 lines 35-41).

17.   As per Claims 3,15, 27 and 39, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 2,14, 26 and 38. Allen

further teaches wherein processing the first address if the first address does not match

the incorrect address record comprises using at least one of the plurality of address

resolution processes (see Col. 4 lines 62-68 and Col. 5 lines 1-4, Examiner is

interpreting one or more possible choices of an addressee and former address as at

least one incorrect address record that does not match the first address). Examiner is

further interpreting an operator selecting from a menu of choices based on known

USPS forwarding rules to obtain a forwarding address for the mailpiece at a delivery

point as an address resolution process.

21.   As per Claims 7, 19, 31 and 43, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein at least one of the plurality of address resolution processes

includes sending an item including the incorrect address record, the item configured to

be delivered in an item delivery system (see Col. 4 lines 41-55), to an element of the

item delivery system that delivers in an area defined by a United States Postal Service

ZIP code included in the incorrect address record (see Col. 4 lines 45-50) wherein a

delivery system operator at least one of verifies, validates, and supplies missing or

incorrect information to be included in the correct address record (see Col. 4 lines 56-58

and Col. 5 lines 1-10).

22.   As per Claims 8, 20, 32 and 44, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein at least one of the plurality of address resolution processes

includes entering the incorrect address record into a database to obtain a correct United

States Postal Service ZIP+4 code to be included in the correct address record (see Col.

6 lines 54-68 and Col. 7 lines 1-4).

23.   As per Claims 9, 21, 33 and 45, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein at least one of the plurality of address resolution processes

includes modifying individual address components of the incorrect address record to

obtain a valid match to a database entry (see Col. 4 lines 62-68 and Col. 5 lines 1-4).

24.   As per Claims 10, 22, 34, and 46, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein at least one of receiving and providing further comprises

utilizing at least one of regular mail, e-mail, facsimile, internet, and an interactive voice

response system (see Col. 4 lines 23-40).

25.   As per Claims 11, 23, 35 and 47, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein at least one of receiving and providing further comprises

communicating over a network (see Col. 4 lines 62-67, Examiner is interpreting a

computer retrieval of information in a database as communication over a network).

26.   As per Claims 12, 24, 36 and 48, Allen in view of Anchor teaches the method,

component, computer-readable medium and systems of claims 1, 13, 25 and 38. Allen

further teaches wherein the first unresolved address includes an incorrect United States

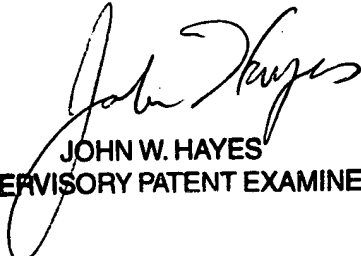Postal Service ZIP+4 code (see Col. 4 lines 23-26 and 30-36).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Tonya Joseph whose telephone number is 571-270-
1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays
off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER